

REMARKS

Upon entry of the present amendment, claims 1-10 will remain pending in the above-identified application and stand ready for further action on the merits.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. For example, the amendment to claim 1 finds support at page 9, line 22 and at page 11, lines 7-8 of the specification. Similarly, support for newly added claims 9-10 occurs at page 19, line 17 and page 34, lines 21-22 of the specification. Accordingly, entry of the present amendment is respectfully requested.

***Claim Rejections Under 35 USC § 103(a)***

Claims 1-8 have been rejected under 35 USC § 103(a) as being unpatentable over EP 1 020 501. Further, claims 1-8 have also been rejected under 35 USC § 103(a) as being unpatentable over EP 1 036 836. Reconsideration and withdrawal of each of these separate rejections is respectfully requested based upon the following considerations.

***The Present Invention and Its Advantages***

The present invention provides a polishing composition which comprises polymer particles and inorganic particles in an aqueous

medium, wherein the inorganic particles have an average particle size and properties as recited in Example 1.

The polishing composition of the present invention can be favorably used in polishing the substrate for precision parts, including semiconductor substrates; substrates for magnetic recording media such as magnetic disks, optical disks and opto-magnetic disks; photomask substrates; glass for liquid crystals; optical lenses; optical mirrors; optical prisms; and the like.

Further, the present invention relates to a polishing composition capable of polishing a substrate to be polished made of silicon, glass, an oxide, a nitride or a metal, or a coated substrate thereof at a high rate, and generating little scratches, a polishing process for a substrate to be polished with the polishing composition, and a process for increasing a rate for polishing a substrate to be polished with the polishing composition.

Distinctions over the Cited Art

EP '501

In EP '501, the mean particle size of the inorganic particles is defined as the very broad range, i.e., from 0.01 to 5  $\mu\text{m}$ . However, the particle sizes used in its Examples are larger than 0.18  $\mu\text{m}$ , and it is not disclosed concretely in the Examples to use particles of which size is not larger than 95 nm as used in the

present invention. As noted in page 9, lines 20-24 of the specification of this application, use of larger size of inorganic particles results in precipitation and separation of the inorganic particles while storing so that it is necessary to re-disperse upon re-using. Scratch may occur unless the precipitated and separated particles are sufficiently re-dispersed. From this viewpoint, we define the upper limit to 95 nm. EP '501 fails to teach such a limitation.

EP '836

The aqueous dispersion of EP '836 contains polymer particles and inorganic particles of which feature is that zeta potential of polymer particles and inorganic particles has opposite signs (see claim 3 of EP '836). Whereas, zeta potential in the present invention is zero or the same sign so that the present invention relates to polishing based on the opposite technical idea to EP '836.

Accordingly, based upon the above remarks and the amendments made herein, reconsideration and withdrawal of each of the Examiner's outstanding rejections is respectfully requested under the provisions of Title 35 of the United States Code.

CONCLUSION

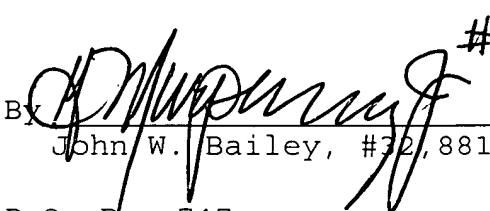
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims 1-10 are allowable at present.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
John W. Bailey, #32,881  
P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

JWB:enm  
1422-0603P